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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,964	08/31/2001	Shawn S. Cornelius	10022/55	1551

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ACCENTURE CHICAGO 28164
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

EXAMINER

DIVECHA, KAMAL B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/943,964

Applicant(s)

CORNELIUS ET AL.

Examiner

KAMAL B. DIVECHA

Art Unit

2151

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-23.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attached document.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER

Examiner maintains the rejection.

The affidavit filed July 15, 2005 is ineffective to overcome the rejection of record.

Applicant attempts to establish prior invention by showing conception of the invention prior to January 19, 2001 (the effective date of the Sato reference) coupled with diligence from before that date up until filing of the instant application on January 31, 2001.

1.132 Affidavits or declarations traversing rejections or objections.

Applicant and/or Inventor can file an affidavit under 37 CFR 1.132 when any claim of an instant application under examination or reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

Although Applicant has labeled the affidavit as being under 37 CFR 1.132, the contents reveal that it is an attempt to antedate a reference and thus is properly treated under 37 CFR 1.131. The analysis below is based upon 1.131 practice.

1.131 Affidavits to antedate a reference.

The affidavit filed on July 15, 2005 is ineffective to overcome the rejection of record.

It appears that Applicant is attempting to antedate Sato reference by a showing of conception prior to January 19, 2001, the effective date of Sato,

coupled with diligence from that point until the effective filing date of the instant application on January 31, 2001.

Formalities

The inventor of the subject matter of the rejected claim, the owner of the patent under examination or reexamination, or the party qualified under 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claims prior to the effective date of the reference on which the rejection is based. MPEP 715.04

The affidavit is not signed by all the inventors and therefore is ineffective on its face.

Although, the lack of proper signatures renders the affidavit ineffective, the Examiner will make some comments about the substance of the affidavit in the interest of moving prosecution along.

SUBSTANCE:

General Considerations:

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883).

Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to

practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (See MPEP 715.07)

Conception

As the sole evidence of conception prior to January 19, 2001, Applicant states in paragraph 5-6 of the affidavit:

“The disclosure corresponding to the ‘538 application and the inventions described therein were conceived prior to January 18, 2001; and the disclosure corresponding to the ‘538 application was made available to the law firm Brinks Hofer Gilson & Lione prior to January 18, 2001”.

The statement made by applicants attorney and the applicant are general assertion that the Exhibit supports conception and as such amounts to “mere pleading”. Applicant has not provided a clear explanation of the exhibits pointing out how the exhibits establish conception of the claimed invention.

Applicant is relying on the specification, abstract, drawings and claims to establish conception. However, the specification, abstract, drawings and claims carries a date AFTER the January 19, 2001, the effective date of the reference used in rejection.

Therefore applicant has not met the burden of establishing prior conception.


With respect to diligence, the Examiner notes that there is not specificity as to the dates and acts. A showing of diligence requires that specific dates and acts be provided.

Applicant has mentioned in the declaration paragraph 2 that the preparation of the '538 application is evidenced by the redacted copy of the time summary attached at tab 1, however the redacted copy of the time summary does not appear in the file or record. In any event, submitting the redacted copy of the time summary generated from the accounting database of the law firm is insufficient to show the conception of the invention prior to January 19, 2001.

For at least the reasons cited above the affidavit is ineffective to antedate the reference.

KD

August 5, 2005.


ZARNI MAUNG
PATENT EXAMINER